

REMARKS

Favorable reconsideration and withdrawal of the objection and rejections set forth in the above-mentioned Official Action in view of the foregoing amendments and the following remarks are respectfully requested.

Drawings

The drawings are objected to under 37 C.F.R. § 1.83(a) for the reasons succinctly set forth in the Official Action. Specifically, the Examiner states that “the positioning unit/pair of grasping planes grasping both end portions of the sheet in a lateral position must be shown or the feature(s) canceled from the claim(s).” The positioning unit/pair of grasping planes grasping both end portions of the sheet in a lateral position correspond to the pair of grasping surfaces 564 shown in Figure 5A. This aspect of the invention is discussed at least at page 15, line 2 *et. seq.* of the specification with reference to Figure 5A. It is respectfully submitted that the feature is shown in the drawings and that the objection to the drawings should be withdrawn.

Claims Status

Claims 1, and 3 through 13 remain pending in the application. Claims 1, 3, 10, and 11 have been amended to even more succinctly define the invention and/or to improve their form. Claims 12 and 13 have been added to accord Applicants an additional scope of protection commensurate with the disclosure. It is respectfully submitted that no new matter has been added. Claims 1, 10, and 11 are the only independent claims pending in the application.

Art Rejections

Claims 1 through 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,763,167 (Watanabe, et al.) in view of U.S. Patent No. 2,872,981 (Fitzpatrick).

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe, et al. in view of Fitzpatrick.

The rationale underlying each of the foregoing art rejections is succinctly set forth in the Official Action.

Response to Art Rejections

The rejections are respectfully traversed.

Amended Claim 1 calls for a sheet processing apparatus which includes a positioning unit arranged to position each of sequentially conveyed sheets at a predetermined position, wherein the positioning unit positions a sheet at a predetermined punching position in a direction substantially orthogonal to a conveying direction of the sheet, by grasping both end portions of the sheet in a lateral direction; an accommodating unit disposed at a portion upstream of the positioning unit and arranged to accommodate a sheet conveyed to the sheet processing apparatus; a punching unit arranged to perform punching one-by-one for a sheet positioned by the positioning unit; a discharge unit arranged to discharge a sheet punched by the punching unit; and a controlling unit arranged to make the positioning unit operate to position one-by-one the sheet prior to a punching operation by the punching unit and to make the accommodating unit accommodate subsequently conveyed sheets during the positioning operation or the punching operation.

Several significant features of Claim 1 include punching a sheet one-by-one, to position the conveyed sheet, prior to a punching operation by a punching unit, in a direction orthogonal to a conveying direction of the sheet by a positioning unit, and accommodating the sheets newly conveyed during the positioning or punching operation to an accommodating unit, which is disposed at a portion upstream of the positioning unit.

These features make it possible to perform high-accuracy punching of the sequentially conveyed sheets.

Watanabe discloses an image forming apparatus which performs punching for loaded sheet bundles. Applicant submits that Watanabe does not disclose or suggest a structure to punch sheets one-by-one; does not disclose or suggest aligning the sheets in a lateral direction; and does not disclose or suggest a structure to convey the subsequent sheet during a punching operation. *A fortiori*, there is no disclosure in Watanabe of an accommodating unit to accommodate the subsequent sheets which are newly conveyed.

The Examiner recognizes that Watanabe does not show grasping both end planes of a sheet in the lateral position. Accordingly, the Examiner relies on Fitzpatrick for allegedly disclosing this feature.

The secondary citation, Fitzpatrick describes a structure that a cutter cuts a half-folded paper conveyed by a belt 4. Fitzpatrick is cited for allegedly disclosing, “the use of a positioning unit/par [*sic.* pair] of grasping planes 30. See Fig. 6, where the other member is in front of the anvil R’ grasping both end portions of the sheet in a lateral position for the purpose of laterally guiding the sheet to the correct position before cutting.” (The so-called “grasping planes” are actually referred to in Fitzpatrick as a “guide 30.”)

However, Fitzpatrick does not disclose or suggest conveying new sheets during the cutting operation and an accommodating unit for the sheets. Moreover, there is no description at what timing planes guide 30 position the sheets.

Therefore, even if the teachings of Watanabe and Fitzpatrick are taken together, the combined teachings will not render obvious the invention cited in amended Claim 1.

Amended independent Claim 10 is directed to an image forming apparatus comprising an image forming unit to form an image on a sheet and the elements of the sheet processing apparatus of amended Claim 1.

Amended independent Claim 11 is a method claim formulated on the basis of amended Claim 1. However, Claim 11 calls for accommodating subsequently conveyed sheets during the position operation and/or the punching operation.

It is respectfully submitted that Claims 10 and 11 are allowable for the reasons noted above with respect to amended Claim 1.

It is also respectfully submitted that the combination rejections are not well founded. The Examiner has provided a *rationalization* for combining the teachings of the cited art based on the benefits of doing so. A combination rejection is proper only when there is some suggestion or motivation in the cited art *per se* to cause one having ordinary skill in the art to combine the teachings of the cited art. There is nothing in the cited art which supports the position that it can be combined in the manner suggested. Even if the art could be so combined, the mere fact that the art can be combined is not sufficient if there is no suggestions in the art that such a combination is desirable. For example, see ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

In view of the foregoing, it is respectfully submitted that independent Claims 1, 10, and 11 are allowable over Watanabe and Fitzpatrick, whether taken individually or in combination.

Dependent Claims

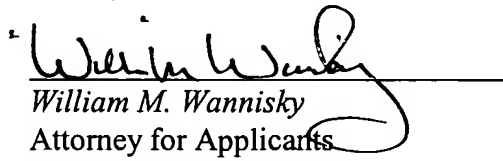
Claims 3 through 9, 12, and 13 depend either directly or indirectly from one of Claims 1, 10, or 11 and are allowable by virtue of their dependency and in their own right for further defining Applicants' invention. Individual consideration of the dependent claims is respectfully requested.

Closing Comments

It is respectfully submitted that the pending claims are allowable over the art of record and that the application is in condition for allowance. Favorable reconsideration and early passage to issue of the present application are earnestly solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our New York office at the address shown below.

Respectfully submitted,


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